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MAY 27 2008

In re Application of	:	
Chu et al	:	
Application No. 09/581,036	:	DECISION ON PETITION
Filed: 08/08/2000	:	
Attorney Docket No. PPD50288UST	:	

This is a decision on the petition under 37 CFR 1.181, filed March 20, 2008, to withdraw the holding of abandonment. This is also a decision on the petition under 37 CFR 1.137(b), filed March 20, 2008, to revive the application.

On November 6, 2002, the Office mailed a final Office action, which set a three-month shortened statutory period to reply. On March 6, 2003, petitioners submitted an amendment in response to the final Office action, accompanied by a request for an extension of time for response within the first month. Unfortunately, the amendment did not place the application in condition for allowance. As petitioners did not file a proper and timely reply to the final Office action within the six-month statutory period to respond, the application became abandoned by operation of law¹ on March 7, 2003.

On May, 14, 2003, after the application had become abandoned, the examiner mailed a Notice of Bona Fide, Non-Responsive Amendment, which stated:

The reply filed on 3/06/2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): form PTO-326 contained an error indicating that the action was non-final, however the office action itself contained no new rejections and indicated in the conclusion that the action was final. The proper response is a REPLY UNDER 37 C.F.R. (i.e. Rule 116 amendment after final action). See 37 CFR 1.111. Since the above- mentioned reply appears to be *bona fide*, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within

¹ When an application is abandoned by the operation of law, applicant's remedy to restore the application to pending status is by filing a petition to revive the abandoned application.

which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

On June 6, 2003, the examiner issued and mailed an Advisory Action, indicating that the amendment of March 6, 2003, did not place the application in condition for allowance. The examiner explained that the application had gone abandoned for failure to submit a proper and timely response to the final Office action. Further, the examiner acknowledged "his errors in marking the Office Action Summary of the final action dated 11/06/2002 and in sending a non-responsive letter requesting a reply under 37 C.F.R. 1.116 after the six month deadline of 5/06/2003." On June 6, 2003, the Office mailed a Notice of Abandonment.

On June 25, 2003, petitioner filed a petition under 37 CFR 1.137(b), which was granted by the decision of October 23, 2003. However, the Office subsequently determined that petitioner did not submit a proper reply with the original petition. Consequently, the Office mailed a Corrected Decision vacating the decision of October 23, 2003, and dismissing the petition of June 25, 2003. Additionally, the Correct Decision stated: "Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

On December 23, 2004, petitioner submitted a response in the form of a Request for Continued Examination ("RCE"), submission, and a request for extension of time for response within the second month. Unfortunately, petitioner did not provide the Office with a request for reconsideration of the Corrected Decision on September 15, 2004, dismissing the petition of June 25, 2003, accompanied by a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)" as indicated by the Office. Thereafter, on February 2, 2005, the Office mailed a Notice of Improper Request for Continued Examination, stating that the RCE was improper because the request was not filed before abandonment of the application. The Notice advised petitioner to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.

On March 20, 2008, petitioner filed the present petition. Petitioner asserted that petitioner did not receive the Notice of Improper Request for Continued Examination or the Notice of Abandonment as evidenced by the petitioner's docket records. Petitioner requested that the Office withdraw the holding of abandonment. The Office notes that the failure to respond to the Notice of Improper Request for Continued Examination did not form the basis for the abandonment of the application. The Notice of Improper Request for Continued Examination did not set any period for reply. That is, the mailing of the Notice did not change the fact that the application had become abandoned on March 7, 2003, by operation of law. The application was properly held abandoned because of petitioner's failure to submit a timely and proper response to the final Office action of November 6, 2002.

As there is no dispute that the application is abandoned, the filing of a petition under 37 CFR 1.181(a) to withdraw the holding of abandonment is inappropriate. See MPEP 711.03(c)(I). The only remedy available to petitioner to revive the application is to file a grantable "Renewed Petition under 37 CFR 1.137(b)."

In view of the above, the petition under 37 CFR 1.181 to withdraw the holding of abandonment is **dismissed**.

As to the petition under 37 CFR 1.137(b), petitioner has satisfied the requirements of 37 CFR 1.137(b) in that petitioner supplied (1) the reply in the form of a RCE, the RCE fee, and a submission required by 37 CFR 1.114; (2) the petition fee; and (3) a proper statement of unintentional delay. Accordingly, the renewed petition under 37 CFR 1.137(b) is **granted**.

The Office notes that petitioner submitted a request for an extension of time within the second month on December 23, 2004, after the application became abandoned. However, any request for extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the \$450.00 extension of time fee was paid on December 23, 2004, after the maximum extendable period for reply, the fee is inappropriate. Accordingly, the \$450.00 extension of time fee will be refunded to petitioner's credit card. Furthermore, no petition fee is required for filing a petition to withdraw the holding of abandonment or a renewed petition under 37 CFR 1.137(b). Thus, the petition fees in the amount of \$130.00 and \$1,540.00 submitted on March 20, 2008 will also be refunded to the petitioner's credit card.

This application is being referred to Technology Center AU 1638 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

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